

a structure for translating movement of a pipetting-needle carrier to the plunger to cause movement of the plunger.

REMARKS

In the last Office Action of October 8, 2002, the Examiner newly rejected claims 7-11, 14, and 15 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner stated that specification does not adequately support the "bi-directional" conveyor recited in claim 7.

Applicants assert that the application, as originally filed, does provide adequate support for the term "bi-directional." Figs. 1, 2, and 4 show arrows depicting the reagent container carrier moving in one direction, and Fig. 7 shows an arrow depicting the reagent container carrier moving in the opposite direction. Additionally, page 8, lines 19-20 of the specification, disclose a "reagent-container carrier, horizontally movable" along the guide (17). Thus, a "bi-directional" conveyor is supported in the application as originally filed. To further prosecution, Applicants propose to amend the specification to recite what is shown in Figs. 1, 2, 4, and 7. Specifically, Applicants propose to amend the fourth full paragraph on page 7 to read, in part, that "the reagent container (12) moves relative to the plunger (11) on the reagent-container carrier (16), the carrier (16) being horizontally moveable along the guide (17) in two directions, as shown in Figs. 4 and 7." As discussed above, this language is fully supported by the originally filed drawings, and no new matter has been added. Applicants respectfully request withdrawal of this rejection.

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Claims 7, 8, and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Abrams (U.S. Patent No. 4,807,425). The Examiner argued that claim 7 does not require the same piston be used to open and close the cap, and that the language used in the "wherein" clause of claim 7 was not considered as a limitation because it raises questions as to the limiting effect of the language in the claim, citing MPEP § 2106(c). Applicants respectfully traverse this rejection.

Applicants believe that the above-cited MPEP section has been improperly applied to the claimed invention. MPEP § 2106 is directed to the patentability of computer-related inventions, specifically inventions implemented on a computer and inventions employing computer-readable media. A closure appliance for a reagent container does not fall into either of those categories, and thus MPEP § 2106 is inapplicable to the claimed invention. Additionally, MPEP § 2106(II)(C) reads that the use of a "wherein" clause may raise a question as to the limiting effect of the language where the claim language suggests or makes optional a particular structure. This analysis, however, does not apply to claim 7, as the language of its "wherein" clause does not suggest or make the limitation to the conveyor structure optional, but instead positively recites that the conveyor is movable in both directions. Thus, in order to reject claim 7 under 35 U.S.C. § 102(b), the Examiner must address how the cited prior art anticipates the positively recited limitation directed to a "bi-directional" conveyor.

The Examiner commented that claim 7 does not require the plunger to both open and close the cap. Applicants disagree. Amended claim 7 recites "a plunger for opening and closing a reagent container stopper by engaging and releasing a catch on the reagent container stopper." Abrams does not disclose a structure that both opens

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and closes stoppers as required by claim 7. Instead, it discloses a first piston 42 for opening the cap, and a second piston 78 downstream from the first piston for closing the opened cap. (Col. 4, lines 44-53 and col. 6, lines 3-11). Abrams also does not disclose or suggest moving the vials in a first direction for opening the vials and moving them in a second, opposite direction for closing them. For at least these reasons, Abrams does not anticipate claim 7 or claims 8-11 and 14-15, which depend from claim 7. Accordingly, reconsideration is respectfully requested.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 7-11 and 14-15 in condition for allowance. Applicants submit that the proposed amendments of claim 7 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

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In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 12, 2003

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APPENDIX TO AMENDMENT AFTER FINAL OF MARCH 12, 2003

VERSION WITH MARKINGS TO SHOW CHANGES MADE

AMENDMENTS TO THE SPECIFICATION

Page 7, fourth full paragraph, please amend to read:

The reagent-container stopper (13) is opened and closed by the plunger (11), which moves relative to the reagent container (12).[,] The plunger (11) engages on a catch (15) [arranged] on the stopper (13) [which is] to be opened, and opens the lid (14) at a predetermined position. The reagent container (12) moves relative to the plunger (11) on the reagent-container carrier (16), the carrier (16) being horizontally movable along the guide (17) in two directions, as shown in Figs. 4 and 7. As the reagent container carrier (16) moves the container (12) in a first direction relative to the plunger (11), the plunger (11) engages the catch (15) and opens the lid as shown in Figs. 3 and 4. When the reagent-container carrier (16) moves the container (12) in a second, opposite direction relative to the plunger (11), the plunger (11) engages the catch (15) and closes the lid (14) as shown in Figs. 6 and 7. The plunger (11), which causes the reagent-container stopper (13) to open and close, can be actuated by the appliance according to the invention. The catch (15) is preferably designed in a such a way that, in the limit position, it can be elastically deflected so far by the plunger that the plunger (11) can be moved beyond the limit position on the reagent container (12).

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AMENDMENTS TO THE CLAIMS

Please amend claim 7 as follows:

7. (Twice Amended) An appliance for opening and closing reagent container stoppers in partially or fully automatic analysis apparatus, comprising:

a plunger for opening and closing a reagent container stopper by [for] engaging and releasing a catch on the [a] reagent container stopper [to be opened or closed], the plunger movable [moveable] between an at rest position and a working position;

an automatic conveyor for moving the reagent container relative to the plunger, wherein the conveyor is movable in a first direction to place the plunger in a position to open the stopper, and wherein the conveyor is movable in a second direction, opposite to the first direction, to place the plunger in a position to close the stopper; and

a structure for translating movement of a pipetting-needle carrier to the plunger to cause movement of the plunger.

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